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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|----------------------|
| 10/736,150 | 12/15/2003 | Osamu Nagai | 13712 | 3663 |
| 7590 | 10/02/2006 | | EXAMINER [REDACTED] | BURCH, MELODY M |
| ORUM & ROTH 53 W. JACKSON BLVD CHICAGO, IL 60604 | | | ART UNIT [REDACTED] | PAPER NUMBER 3683 |

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/736,150 | NAGAI, OSAMU |
| | Examiner | Art Unit |
| | Melody M. Burch | 3683 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 December 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/06 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of one shock absorber exclusively damping during compression and the other shock absorber exclusively damping during expansion as recited in claims 2 and 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The originally filed specification fails to provide support for the phrase "except for unintended frictional effects, exclusively" in claims 1, 2, 13, and 14.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 2, 4, 6, 8, 10, 12, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In lines 3-4 of claim 2 and in lines 4-5 of claim 14 the phrase "except for unintended frictional effects, exclusively" does not enable one to make and/or use the invention in light of the drawings and portions of the originally filed specification. Although paragraph [0051] of the published application states "dampened by the compression side damping force generated by the compression side damping force generating means 101 of the hydraulic shock absorber 100 in the compression stroke, and by the expansion side damping force generated by the expansion side damping force generating means 201 of the hydraulic shock absorber 200 in the expansion stroke", the drawings as well as other paragraphs of the published application suggest that the shock absorbers do not have *exclusive* damping characteristics as claimed. For example, compression side damping force generating structure 101 shows both a check valve 43 for damping flow resulting from compression strokes as described in paragraph [0031] and a check valve 44 for damping flow

resulting from expansion strokes as described in paragraph [0034]. Similar illustrations and descriptions exist for the expansion side damping force generating structure. In light of the illustrations and various sections of the specification supporting non-exclusive compression and expansion damping, the description does not enable one to make or use the exclusive damping aspect of the claimed invention. The remaining claims are rejected due to their dependency from claim 1.

7. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "except for unintended frictional effects, exclusively" in claims 1, 2, 13, and 14 since it not explicitly set forth in this manner in the originally filed specification.

The remaining claims are rejected due to their dependency from claims 1 and 2.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 5, 7, 9, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5797594 to Sekine et al. in view of JP-6441495 (JP'495).

Re: claims 1 and 13. Sekine et al. show in figure 1 a hydraulic shock absorbing apparatus of a vehicle comprising: a compression side damping force generating structure for mainly generating a compression side damping force is provided in one hydraulic shock absorber, the one hydraulic shock absorber having a vehicle body side tube 2 and a wheel side tube shown surrounding tube 2 near the bottom of tube 2 which are slidably fitted to each other; a damper having a damper cylinder 8,11 and 8,11,19 in another perspective and a piston rod 18 in which a piston slidable within the damper cylinder is mountable to a leading end portion thereof, and structured such that the damper cylinder is mountable to an inner side of the wheel side tube via intermediate element 3 and the piston rod is mountable to an inner side of the vehicle body side tube via intervening element 9; a piston rod side oil chamber 8a and a piston side oil chamber 8b sectioned within the damper cylinder by the piston, an oil reservoir chamber 10 disposed in an outer periphery of the damper cylinder; and two oil passages 20,21 provided in the piston, a compression side damping valve 23 being provided in one oil passage, and a check valve 22 closing during compression and opening during expansion being provided in the other oil passage, and wherein a volume compensating oil passage 14 communicating the piston rod side oil chamber with the oil reservoir chamber is provided as recited in col. 8 lines 62-67.

Sekine et al. describe the invention substantially as set forth above, but is silent as to having one of the shock absorbers at right and left sides of a wheel with an expansion side damping force generating structure for mainly generating an expansion side damping force being provided in another hydraulic shock absorber.

JP'495 teaches in pgs 1-2 of the description of the related art section of the instant specification the use of having shock absorbers at both sides of a wheel with one absorber providing the expansion side damping force generating apparatus and the other of the other of the absorbers providing the compression side damping force generating apparatus.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shock absorber arrangement of Sekine et al. to have included one of the shock absorbers on both sides of a wheel, as taught by JP'495, in order to provide a means of effectively damping both expansion and compression strokes for a wheel to improve the feel of the ride.

Re: claim 3. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein a bypass oil passage 44 communicating the oil chambers in both sides of the piston is disposed in the piston rod of each of the hydraulic shock absorbers, and a damping force adjusting valve 28a is disposed in the bypass oil passage.

Re: claims 5 and 7. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 19 of the one hydraulic shock absorber is disposed in a side wall 19 in the other perspective of the damper cylinder.

Re: claims 9 and 11. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 19 for compensating the volume of the respective piston rod of the one hydraulic shock absorber is disposed in a guide member 19 for guiding the piston rod 18.

Allowable Subject Matter

10. Claims 2, 4, 6, 8, 10, 12, and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Response to Arguments

11. Applicant's arguments filed 8/4/06 have been fully considered but they are not persuasive.

Applicant argues that JP'495 shows the limitation wherein "just one hydraulic shock absorber has both of a compression side damping force generating structure and an expansion side damping force generating structure." Applicant also argues that the Examiner "mischaracterized the Sekine reference to the extent she finds in this reference a teaching that separate shock absorbers are exclusively responsible for respective compression and expansion damping in the Sekine reference." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner reiterates that it is Sekine, *as modified*, that describes the claimed invention. Applicant's statement that JP'495 shows just one hydraulic shock absorber having both of a compression side damping force generating structure and an expansion side damping force generating structure is incorrect. Applicant admits in lines 9-11 of pg. 1 of the

instant application that JP'495 shows *two* shock absorbers – one on the right side of the wheel and one on the left side of the wheel. In the combination above, Sekine is used for the detailed structure of the shock absorber and JP'495 is used for the teaching of having one shock absorber on one side of the wheel and another shock absorber on the other side of the wheel.

Applicant's invention is embodied in two types of claims. The first type of claim, as set forth in claims 1 and 13, describes a shock absorbing apparatus in which there are two shock absorbers, one on each side of a wheel, wherein there is a compression side damping force generating structure for exclusive compression side damping in one of the shock absorbers and an expansion side damping force generating structure for generating exclusively an expansion side damping force in the other of the shock absorbers. As best understood, the compression side damping force generating structure of Sekine et al., as modified, is capable of generating exclusively a compression side damping force by virtue of it being a *compression* side damping force generating structure. In other words, the compression side damping force generating structure generates exclusively a *compression* side damping force since it by definition blocks flow and, therefore, does not participate in damping during expansion. The same analysis holds true for the expansion side damping of Sekine, as modified. The second type of claim, as set forth in claims 2 and 14, recites the dual shock absorber arrangement, but instead claims that one of the shock absorbers is arranged to damp exclusively during compression and the other of the shock absorbers is arranged to damp exclusively during expansion. Examiner agrees that Sekine, as modified, fails to

show or suggest one shock absorber being used exclusively for damping during compression and the other being used exclusively for damping during expansion since each of the shock absorbers of Sekine, as modified, has both compression and expansion capabilities. For this reason, Examiner has withdrawn the rejections of claims 2, 4, 6, 8, 10, 12, and 14 using Sekine, as modified. Examiner, however, has also included a 112 first rejection of the claims since the drawings of the instant invention and portions of the originally filed specification indicate that the instant invention also shows each of its shock absorbers having both compression and expansion capabilities. See paragraph 3 of the instant Office action for details.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3683

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mm
September 26, 2006

Melody M. Burch
Melody M. Burch
Primary Examiner
Art Unit 3683

9/26/06